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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTO	R	ATTORNEY DOCKET NO.
09/000,924	12/30/ 9 7	HASEBE	Т	1083.1048/J[
<u>.</u>		TM02/0410	1	EXAMINER
STAAS & HALSEY 700 ELEVENTH STREET N W			NGU	YEN, C
SUITE 500		M t	ART UNIT	PAPER NUMBER
WASHINGTON	DC 20001	•	216	5
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

PTO-90C (Rev.11/00)



Office Action Summary

Application No. 09/000,924

Cuong H. Nguyen

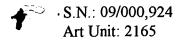
Applicant(s)

Examiner

Group Art Unit 2165

Hasebe et al.

X Responsive to communication(s) filed on _Mar 22, 2001	
☐ This action is FINAL.	
Since this application is in condition for allowance except for formal matters, prosecution as in accordance with the practice under Ex parte Quay/1035 C.D. 11; 453 O.G. 213.	to the merits is closed
A shortened statutory period for response to this action is set to expire3month(s), or the longer, from the mailing date of this communication. Failure to respond within the period for responding application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the 37 CFR 1.136(a).	se will cause the
Disposition of Claim	
	lare pending in the applicat
Of the above, claim(s) is/are	withdrawn from consideration
☐ Claim(s)	
Claim(s)	is/are rejected.
Claim(s)	
	ction or election requirement.
Application Papers See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948. The drawing(s) filed on is/are objected to by the Examiner. The proposed drawing correction, filed on is approved	
Attachment(s) Notice of References Cited, PTO-892 Information Disclosure Statement(s), PTO-1449, Paper No(s). Interview Summary, PTO-413 Notice of Draftsperson's Patent Drawing Review, PTO-948 Notice of Informal Patent Application, PTO-152	·
SEE OFFICE ACTION ON THE FOLLOWING PAGES	



DETAILED ACTION

- 1. This Office Action is the facsimile communication received on 3/22/2001.
- 2. Claims 1-23 are pending in this application. Claim 23 is requested to be added.

Election/Restriction

- 3. After further consideration, the election to one of the following invention is deemed necessary. The delay of this requirement is regretted by the examiner of record.
- 4. Restriction to one of the following inventions is required under 35 U.S.C.§ 121;
- I. Claims 1-3, 4-8, 9-11, 12-14, 15-17, 18, 20, 22, and 23, drawn to a system for protecting input data requiring authorization for use during utilization of the input data, classified in US class 713, subclass 189.
- II. Claims 19, 21, drawn to a method of processing input data requiring authorization for use, classified in class 705, subclass 51.
- 5. The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if



either of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product, or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process for using the product as claimed can be practiced with another materially different product, e.g., a method of processing input data requiring authorization for use in online commercial database searching using a host server.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicants is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR § 1.143).

7. The following rejections are based on the examiner's broadest reasonable interpretation of the claims, *In re Pearson*, 181 USPQ 641 (CCPA 1974).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C.§ 112:

The specification shall conclude with claims particularly pointing out and distinctly claiming the subject matter which the applicants regard as their invention.

Claim 20 is rejected under 35 U.S.C.§ 112, second paragraph, as failing to set forth the subject matter which applicants regard as their invention. Since there is no preamble in the introductory part of these claims. The examiner submits that statements in this claim about intended uses, capabilities, and structures, or structural relationships, as positive structural limitations; these claims are not particularly pointed out and distinctly claimed within the meaning of section 112 because of lacking preamble statements. applicants should aware of the necessity for limiting their claims. In this sense, these claims fail to comply with section 112, 2nd para., in failing distinctly to claim what is his actual invention. "There is no positive recitation of any structural cooperation among the element listed", this rejection as in fact based on the ground that the claims are incomplete, and therefore,

indefinite and in this way do not conform to the requirement of 35 U.S.C. § 112.

9. Note: Also, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

- The phrase of "what kind of processing has been applied by said processing unit to the generated data, which includes the input data, as being processed, in the compound data" is not weighted much because the claim (e.g. claim 20) is about "a device", that contains a saving unit storing information. This "storing means" has a weight in the claim, not the containing information of "indicating what kind of processing has been applied by said processing unit to the generated data, which includes the input data, as being processed, in the

compound data"; furthermore, "what kind of processing" is indefinite.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Cuong H. Nguyen, whose telephone number is (703)305-4553. The examiner can normally be reached on Monday-Friday from 7:00 AM-3:30 PM.

Any response to this action should be mailed to:

Amendments

Commissioner of Patents and Trademarks c/o Technology Center 2100 Washington, D.C. 20231

or faxed to:

(703) 308-9051 (for formal communications intended for entry)

Or: (703) 305-0040 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the

Group receptionist whose telephone number is (703)305-3900.

Cuong 74. Nguyen

Patent Examiner Mar. 23, 2001